

REMARKS

Applicant notes the comments in the Advisory Action mailed November 3, 2006.

The comments mention the restriction requirement mailed June 16, 2006 and notes that the claims as amended but not entered do not provide a genus claim and simply the issues for appeal. As discussed with the Examiner over the phone on November 21, 2006 and previously and as mentioned in Advisory Action mailed August 31, 2006, Applicant has further amended Claim 41 as a genus claim.

In the advisory action mailed August 31, 2006, the advisory action notes the following.

Continuation of 3. NOTE: Claim 1 appears to be allowable over the prior art, subject to further review as to whether its dependent claims are supported in the original disclosure. Proposed claim 41 does not simplify the issues in that the language is vague as to whether the optional cannulated follower member must satisfy the same functional limitations (on lines 4-6) imposed on the other option, the lead screw. The term "away from" (line 10) may also be vague and confusing in that the guide wire does not appear to be spaced apart (or "away") from the cannulated driver member but rather extends through said driver member during the procedure. The Applicant may have intended to refer to a proximal or a distal portion of the guide wire, but such is not found in the claim language. In the previously applied Schoenfeld reference, the follower member (22) can rotate with the driver member (25), and the guide wire (58) can move relative to the driver member because of the slots (56). For the above reasons, the proposed amendment does not materially reduce or simplify the issues for appeal.

Applicant has amended Claim 41 in light of the restriction requirement noted in the Advisory Action mailed November 3, 2006 and the remarks about the genus claim as noted above and discussed further herein.

Claims 1, 2, 5 – 9, 11, 18, 25, 41 – 44 and 47 – 51 are now pending in the application. While the following amendments and new claims have been presented and paid for in previous responses, they have not been entered so the following status of the claims remains applicable. Minor amendments have been made to Claims 5, 6, 18 and 25 to adjust the dependency of the claims and to add punctuation to improve clarity. Claims 3, 4, 10, 12 – 17, 19 – 24, 26 – 40, 45 and 46 have been cancelled without prejudice to or disclaimer of the subject matter contained therein. New Claims 50 and

51 have been added but are now noted as previously presented as fees for the claims have already been paid. Claims 1, 5, 6, 18, 25, 41, 42, 43, 47, 48 and 49 have been amended. Support for the new and amended claims can be found throughout the application as originally filed and, therefore, no new matter has been added. Examples of support for the new and amended claims can be found at Figures 6, 7, 8 and 14 and paragraphs [0039] through [0042] and [0049] through [0051]. All of the new and amended claims include subject matter from previously presented claims and therefore a new search is not required. The Examiner is respectfully requested to reconsider and withdraw the following objections and rejections in view of the amendments and the remarks below.

CONTACT WITH THE EXAMINER

Applicant thanks the Examiner for the courtesies extended during telephonic conversations on August 9, 2006, August 11, 2006, September 27, 2006 and November 21, 2006, with one of the attorneys of record, Joshua B. Dobrowitsky (Reg. No. 51,288). While no formal agreements were reached, the prosecution history and the claims and references of record were discussed.

In discussions, the Examiner and attorney of record tentatively agreed that Schoenefeld (U.S. Patent No. 6,827,722), as best understood by Applicant, discloses maintaining a guide wire at a fixed distance from the tissue, while a medical device is being inserted. There was also a tentative agreement that Claim 41 would be allowable if drafted as a genus claim for all of the examples illustrated in the Figures and further drafted to include the applicable limitations of allowable Claim 42. There was a further

tentative agreement that subject matter found in the claims included in the restriction requirement, i.e., Claims 21, 25 and 35 – 40, could be included in one or more dependent claims that depend on Claim 1 or Claim 41.

ALLOWABLE SUBJECT MATTER

The office action states that Claims 4 – 9 and 42 are objected to as being dependant upon a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claim and intervening claims. Applicant has amended Claim 1 to include the limitations of Claims 3 and 4. Claims 5 and 6 have been amended to now be dependant on Claim 1 and Claims 7, 8 and 9 remain dependant on Claim 6. Claim 41 has been amended to include portions of Claim 42 that are applicable to the lead screw, as discussed with the Examiner.

RESTRICTION REQUIREMENT

In response to the Restriction Requirement of Claims 21, 25, 35 – 40 and 45 – 49, Applicant elects to withdraw Claims 21, and 35 - 40 from consideration, as being directed to a non-elected invention in accordance with 37 C.F.R. § 1.142(b). Applicant has amended Claim 25 to be dependant upon allowable Claim 1. Applicant has cancelled Claims 45 and 46 without prejudice to or disclaimer of the subject matter contained therein. Claims 47, 48 and 49 have been amended to depend upon Claim 41. The subject matter contained in Claims 37 and 38 have been reproduced in new Claims 50 and 51.

SUPPORT FOR THE AMENDED AND NEW CLAIMS

As noted above, support for the new and amended claims can be found throughout the application as originally filed. Examples of support for the new and amended claims can be found at Figures 6, 7, 8 and 14 and paragraphs [0039] through [0042] and [0049] through [0051].

CLAIMS OBJECTIONS

Claim 1 stands objected to for an informality. Applicant has amended Claim 1 and respectfully accommodated the objection.

REJECTION UNDER 35 U.S.C. § 102

Claims 1, 2, 11, 18, 41, 43, and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schoenefeld (U.S. Pat. No. 6,827,722). This rejection is respectfully traversed.

Claims 1, 2, 5 – 9, 11, 18 and 25

Claim 1 has been amended to include the allowable limitations of Claim 4 and, therefore, Claim 1 is now allowable. Claims 2, 5 – 9, 11, 18 and 25 are dependant upon Claim 1 and, therefore, are allowable.

Claim 41 has been amended to clarify, in part, a clasping device is rotatably coupled to the cannulated follower member or the lead screw and operable to engage the guide wire and to move the proximal end of the guide wire away from the cannulated driver member as the cannulated driver member rotates. Schoenefeld, in contrast, only holds the guide wire at a fixed distance from the tissue and thus prevents the tool from driving the guide wire further into the tissue. The guide wire is held at a fixed distance because the guide wire holder is configured to slide relative to an outer shaft that can be rotated to insert the medical device. See Abstract; Col. 3, Lines 56 – 62; Col. 4, Lines 23 – 36. Applicant respectfully submits that Schoenefeld does not show, teach or suggest, the clasping device rotatably coupled to the cannulated follower member or the lead screw and operable to engage the guide wire and operable to move the guide wire away from the cannulated driver member as the cannulated driver member rotates.

As previously discussed with the Examiner, amended Claim 41 defines a genus claim for all of the disclosed teachings. It was tentatively agreed that the genus claim would be allowable as amended because Schoenefeld does not show the guide wire moving away from the cannulated driver member while the cannulated driver member rotates.

As noted in the statement from the Advisory Action mailed on August 31, 2006 and set forth on page 10 of this response, Applicant has amended Claim 41 so as to clarify the applicable functional limitations of the cannulated follower member and the lead screw. Applicant has also amended Claim 41, in part, to define that the clasping

device is rotateably coupled to the cannulated follower member or the lead screw and is operable to engage the guide wire and to move the proximal end of the guide wire away from the cannulated driver member as the cannulated driver member rotates. As such, Applicant respectfully submits that the limitation containing the term "away from" is neither vague nor confusing.


For at least the above reasons, Claim 41 should be allowable. Claims 42 -- 44 and 47 -- 51 are dependant upon Claim 41 and should be allowable for at least the above reasons.

CONCLUSION

It is believed that all of the stated grounds of objection and rejection have been properly traversed, rendered moot or accommodated. It is believed that a full and complete response has been made to the outstanding Final Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is always invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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